

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re application of

Mark L. Aronson

Serial No. 10/008,933

Examiner: Hence, Andrea A.

Filed November 9, 2001

Group Art Unit: 2854

Entitled: Lock for a hand stamping device

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Pittsburgh, Pennsylvania 15237
December 29, 2003

Brief for Appellant Under 37 CFR §1.192

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Alexandria, VA 22313-1450

Sir:

Brief for Appellant Under 37 CFR §1.192

(1) Real Party in Interest
Mark L. Aronson

(2) Related Appeals and Interferences
None

(3) Status of Claims
Claims 1-10 have been finally rejected pursuant to an Official Action dated May 28, 2003.

(4) Status of Amendments
There have been no amendments filed subsequent to the final rejection.

(5) Summary of Invention

The invention provides a lock apparatus for controlling the operation of a hand stamping device. (Page 1, lines 6-7) The objective of the invention is to prevent unauthorized use of a hand stamping device by preventing access to proprietary indicia on a platen. (Page 2, lines 4-5)

The hand stamping device 10 shown in Figures 1, 2 and 3 comprises a hollow base frame 11 with side walls 12 and 14 joined to end walls 16 and 18 all terminating at an open rectangular end face 20 to bear against a supporting surface containing a document to receive a stamped impression thereon. The walls form boundaries to a window of a frame cavity 22 in which a stamp platen 24 can be displaced from an inking position in a confronting relation with an inking pad in the upper part of the base frame 11 to a stamping position lying in the window at the end face 20. Cam followers move along cam tracks 26 to invert the stamp platen during the course of travel between the inking position and the stamping position. An upper actuator frame 28 is formed by side walls and end walls closed by a top wall 38 forming an internal cavity to fit with and move along the base frame member 11 for providing the driving force to move the cam followers along the cam tracks. (Page 3, line 20 – page 4, line 14)

The lock apparatus 50 shown in Figures 4 and 5 includes two locking heads 52 and 54 interconnected in a rigid space apart relation by parallel spaced apart struts 56 and 58 to form a ridged releasably interconnection with the base frame 11 and the upper actuator frame 28, respectfully between locking heads 52 and 54. The locking heads receive the hand stamping device 10 between the struts whereby the locking heads and struts encircle the outer periphery of

the hand stamping device 10. A key operated lock 60 interlocks the locking heads in a spaced apart relation between the struts. (Page 4, line 15 - page 5, line 4)

The locking head 52 as shown in Figures 6 - 8 has an upstanding, parallel anchor walls 62 and 64 protruding from an elongated back wall 66 provided with a lug 68 and a tab 70 with an aperture 72 outwardly beyond the opposite ends of the elongated back wall 66. The locking head 54 as shown in Figures 9 – 11 has an upstanding anchor walls 74 and 76 extend toward each other at acute angles from an elongated back wall 78 and the struts 56 and 58 are formed as parallel and perpendicular extensions integral with the back wall 78. The terminal end of strut 56 is formed with a slot 80 for receiving the leg hinge lug 68 used to form a hinge interconnection between the strut 58 and locking head 52. The terminal end of the strut 58 is freely pass through the aperture 72 and the end portion projecting there beyond is formed with an annular aperture 82 for receiving a lock bar 60A of the lock 60. The back wall 78 of the locking head 54 is defined by a length and width substantially corresponding to length and width of the window in the base frame. The anchor walls 74 and 76 extend into the frame cavity 22 and into a closely spaced and confronting relation with the platen 24 to prevent advancing movement of the stamp platen toward the window of the frame cavity and thereby also prevent useful access to the stamp platen. (Page 5, line 5 - page 6, line 5)

Figures 4, 5, 12 and 13 illustrate the assembling of the hand stamping device 10 and the lock apparatus 50. The lug 68 is assembled in the slot 80 and the back wall 66 positioned to extend parallel with strut 58. The hand stamping device 10 is introduced between the parallel anchor walls 62 and 64 and advanced between the struts 56 and 58 to a seated position shown in Figures 4 and 5 in which the end face 20 abuts the back wall 78 of a locking head 54 and the

anchor walls 74 and 76 extend into the frame cavity 22 and prevent advancing movement of the platen in the frame cavity 22. There after the locking head 52 is rotated about the hinged connection formed by the engagement of the lug 68 in the slot 80. The parallel anchor walls 62 and 64 pass along opposite sides of the actuator frame 28 thus entrapping the actuator frame when the aperture 82 in the end portion of strut 56 passes through the aperture 72 sufficiently allows the installation of the lock bar 60A of the lock 60 in the aperture 82. (Page 6, line 6 - 17).

6. Issues

The broad issues presented in this appeal are whether the differences between the subject matter of claims 1-10 and the prior art references are such that the subject matter of the present invention, taken as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art.

More particularly, the issue is whether claims 1-10 are unpatentable under 35 U.S.C. §103 as obvious over the Webb reference (US 4,353,521) in combination with the Mitsubishi reference (JP 0,121,755).

7. Grouping of the Claims

Appealed claims 1-10 stand or fall together.

(8) Argument.

The rejection of applicants claims 1 -10 is in error because the Webb and Mitsubishi references do not describe the Applicants claim recitations as more specifically stated in Claim 1 of:

- A) A lock apparatus in combination with a hand stamping device;
- B) a hand stamping devise including an actuator frame slidably relative to a base frame to present a stamp platen residing in a frame cavity to a window in said base frame,
- C) a lock apparatus including the combination of: locking heads having upstanding anchor walls protruding from a back wall such that the

- anchor walls of one locking head receive said actuator frame (*an actuator frame slidable relative to a base frame to present a stamp platen residing in a frame cavity to a window in said base frame*) and the anchor walls of the other locking head extend in said a frame cavity (*an actuator frame slidable relative to a base frame to present a stamp platen residing in a frame cavity to a window in said base frame*) to prevent access to said stamp platen;
- D) struts for connecting said locking heads (as defined in item C above) in a space apart relation with said anchor walls (as defined in item C above) extending toward each other for receiving said actuator frame and base frame of said hand stamping device there between; and
 - E) a lock for interlocking said locking heads (as defined in items C and D above) in a spaced apart relation between said struts(as defined in item D above).

An accurate determination of the scope and content of the Webb reference as well as the Mitsubishi references as required by the Supreme Court in Graham v. John Deere 148 USPQ 459 is clearly lacking. 35 U.S.C. 103 is identified as the basis for the final rejection of appellants claims 1-10, but the application of the prior art is framed as an anticipation under 35 U.S.C. 102 relying only on the Webb reference. Attention is respectfully directed to the final paragraph on Page 2 of the final rejection: “Webb shows an anti-theft device that includes all of the limitations recited in claims 1-10.” The Webb reference is entitled ANTI-THEFT DEVICE, but Appellant’s claims and disclosure recite *A lock apparatus in combination with a hand stamping device*. It is respectfully pointed out that the objects of the Appellant’s invention as set forth on page 2 of the specification are clearly addressed to a solution to a specific problem by the construction of a locking apparatus to the prevention of use and obstruction of access to a hand stamping device. The argument of the rejection that follows asserts a catalogue of parts appearing in the Appellant’s claims is shown in the Webb reference.

In Glaverbel Societe Anonyme v. Northlake Marketing & Supply Inc. 33

USPQ2d 1496 (Fed. Cir. 1995) at 1498, the principle of anticipation was explained by the Court.

"In determining whether a patented invention is anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described. If needed to impart clarity or avoid ambiguity, the prosecution history and the prior art may also be consulted in order to ascertain whether the patentee's invention is novel or was previously known to the art." *Lindemann*, 730 F.2d at 1458, 221 USPQ at 485 ("In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history and identify corresponding elements disclosed in the allegedly anticipating reference.") Cf. *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed.Cir.1987) (Claims are not interpreted "in a Vacuum").

The examiner has not carried the burden of establishing anticipation. The claimed recitations have not been read in light of Appellant's specification and the rejection should be reversed.

In the rejection of claim 1 under 35 USC §103 the Webb reference is relied upon for a contention that:

"Webb shows a lock apparatus including the combination of locking heads (20, 49) having upstanding anchor walls (inside walls of vertical members of (49)) protruding from a back wall (side walls of vertical members of (49)) such that the anchor walls of one locking head (49) receive *a tangible object* and the anchor walls (34) of the other locking head (20); struts (42), (44) for connecting said locking heads in a space apart relation with said anchor walls extending toward each other; and a lock (56) for interlocking said locking heads in a spaced apart relation between said struts." (Emphasis added)

The rejection is wrong because the inserted reference numerals from the Webb reference rewrite the specification of the Webb reference using applicants claim terminology and then only with the improper hindsight use of Appellant's invention. Reference numeral 20 of Webb identifies a securing assembly 20.

"In accordance with this invention, a valuable object 10, such as a starter motor, generator or battery, having a flanged base 12 adjacent to the mounting surface 14 of a second object 18, as best seen in FIG. 5, is secured to said surface by means of a securing assembly 20. The securing assembly 20 comprises a first securing bar 22 positioned overlying one side or portion of the flange 12, and a second securing bar 24, overlying the flange 12 on the opposite side of the object 10." (Column 3, lines 10-18)

Webb's specification was rewritten as to the securing assembly 20 and the retaining loop or

loops 48, 49 by the assertion that the assembly, in receives *a tangible object* and ignores that appellant's disclosure and claim recitation provides two locking heads 52 and 54 as shown in Figures 4 and 5 having:

"upstanding anchor walls 62 and 64 protruding from a back wall 66 such that the anchor walls of one locking head *receive* said actuator frame 30 and the anchor walls 74 and 76 of the other locking head *extend* in said frame cavity 20 to prevent access to said stamp platen 24(Figure 3);"(Emphasis added)

Webb does not disclose one of two locking heads *receiving* an actuator frame and the other of the two locking heads *extending* in a frame cavity. The notion of a frame cavity is wholly foreign to the Webb disclosure. The recitations of: said actuator frame; said frame cavity; and said stamp platen cannot be ignored and neither can the explicit relationships between these recitations all appearing in appellant's claim 1. Accordingly, claim 1 and therefore dependent claims 2-10 all recite the combinations of a hand stamping device and locking apparatus.

The Webb reference does not disclose or suggest a device that prevents access to a stamp platen nor the prevention of operation of a stamping device. The Webb lock is intended and designed to be inserted along spaced apart flanges of the mounting for a static structure and does not provide elements of the lock to prevent operation of the stamping device that might otherwise occur. The Webb device prevents access to a static structure and not the concepts of disabling the operation of a mechanical structure of a stamping device. The applicant's invention is clearly diverse from the construction and function of the Webb cited prior art reference. An examination of the Webb specification shows it is addressed to:

"An anti-theft device to prevent the unauthorized removal of a mounted, flanged object comprising a cover overlying the mounting flanges of the object, a securing device for attaching the cover to the surface upon which the flanged object is mounted and a locking device for preventing removal of the cover from the securing device. The invention is particularly useful in remote oil field and other field uses to prevent theft of industrial machine accessories such as starters, generators,

and batteries. (see the abstract)”

See also:

“Based on the foregoing description, the present invention meets a number of worthwhile objectives. A cover device is provided to prevent the removal of valuable flanged objects from surfaces to which they are mounted or attached, the device preventing access to the bolts or other devices by which the valuable object is attached to the surface, so as to prevent its unauthorized removal. The device of this invention, when locked into place, prevents the movement of the valuable object relative to the adjacent surface in any direction, so that it cannot be removed without authorization.” (Column 2, lines 41-52)

It is well established by the Graham Decision *supra* that any rejection under 35 U.S.C. 103 must be supported by a factual basis in the reference relied upon. In rejecting claims under 35 USC § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed.Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed.Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). The argument of this rejection is clearly based on the impermissible hindsight reconstruction of applicant's claimed invention as there is clearly no basis in the references themselves to support the combination. The argument of the rejection fails to advance any reason why one would modify the references particularly the modifications to do something the references do not even merely suggest. To combine references the obviousness of the combination of references must come from the references themselves not from the impermissible hindsight use of Appellant's invention.

Appellant argues that there is a lack of motivation to combine such references. As

stated in In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986) and recently affirmed in In re Hans Oetker 24 USPQ 2d 1443, in order to rely on a reference as a basis for rejection of the Appellant's invention, the reference must either be in the field of Appellant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned such that a person of ordinary skill in the art would reasonably be expected to look in that field for a solution to the problem facing the invention. The rejection must provide a factual basis founded in objective teaching of the cited references leading to a legal conclusion of obviousness. *In re Fine*, 5USPQ2d 1596 (Fed Cir. 1988); and *In re Lalu*, 223 USPQ 1257 (Fed Cir. 1984). The Federal Circuit reiterated in *In re Fine*:

“[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” 5 USPQ2d at 1600 quoting from *W.L. Gore*, 220 USPQ 303, 312-313 (Fed. Cir. 1983)

The rejection of Appellant's claims is in error because the Webb and Mitsubishi references do not describe or suggest the claimed inventions as more specifically stated in independent claim 1 its dependent claims 2 -10 all calling for a hand stamping device combined with a lock device. The Mitsubishi does not prevent use of a stamping device nor access to the stamp pad. The concept of locking heads interconnected by struts as recited by Appellant's claims is also wholly foreign to the Mitsubishi reference. The lid 4 of the Mitsubishi device is allowed to be opened for use any time as desired and never prevented.

The issue before the Board in the present case, the rejection has fundamentally failed to identify any objective teaching or suggestion by the references to support the conclusion

of obviousness.

For the foregoing reasons, the Appellant requests that the rejection of Appellant's claims be overturned.

Respectfully submitted,



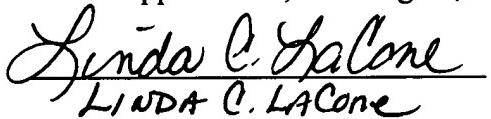
Clifford A. Poff

Registration No. 24,764

Agent for Appellant

CAPoff/lcl
Enclosures
(412) 765-1580
Fax No. (412) 765-1583

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Linda C. LaCone
LINDA C. LACONE

Date: December 29, 2003

Appendix A

Claims

1. A lock apparatus in combination with a hand stamping device, said hand stamping devise including an actuator frame slidable relative to a base frame to present a stamp platen residing in a frame cavity to a window in said base frame, said lock apparatus including the combination of:

locking heads having upstanding anchor walls protruding from a back wall such that the anchor walls of one locking head receive said actuator frame and the anchor walls of the other locking head extend in said a frame cavity to prevent access to said stamp platen;

struts for connecting said locking heads in a space apart relation with said anchor walls extending toward each other for receiving said actuator frame and base frame of said hand stamping device there between; and

a lock for interlocking said locking heads in a spaced apart relation between said struts.

2. The lock apparatus according to claim 1 further including releasably interconnecting tab and slot connectors carried by one of said locking heads and one of said struts.

3. The lock apparatus according to claim 1 further including releasably interconnecting tab and slot connectors carried by one of said locking heads and one of said struts for receiving said lock.

4. The lock apparatus according to claim 1 wherein said struts are integral with one of said locking heads.

5. The lock apparatus according to claim 1 wherein said anchor walls extend in a parallel spaced apart relation from one of said locking heads.

6. The lock apparatus according to claim 1 wherein said anchor walls extend in a converging angler relation from one of said locking heads.

7. The lock apparatus according to claim 6 wherein the anchor walls of said one locking head have an extending length for protruding into said frame cavity a distance sufficient to prevent movement of said stamp platen.

8. The lock apparatus according to claim 6 wherein said anchor walls extend in a parallel spaced apart relation from the other of said locking heads.

9. The lock apparatus according to claim 1 wherein said back wall of said other locking head is defined by a length and width substantially corresponding to a length and width of said window in the base frame.

10. The lock apparatus according to claim 1 wherein said back wall of said other locking head is defined by a length and width substantially corresponding to a length and width of said window in said base frame and wherein the anchor walls of said one locking head have an extending length for protruding along opposite sides of said anchor frame to entrap the anchor from there between.